

REMARKS/ARGUMENTS

1.) Claim Amendments

Claims 1-11 and 13-17 are pending in the application. The Applicant has amended claims 13, 14, 16, and 17. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

2.) Examiner Objections - Specification

In paragraph 1 of the Office Action, the Examiner objected to the disclosure because of various informalities. The Applicant has amended the disclosure to correct the informalities. The Examiner's approval of the amended disclosure is respectfully requested.

3.) Examiner Objections - Drawings

In paragraph 2 of the Office Action, the Examiner objected to FIGS. 3, 4, 6, and 7 for various informalities. Corrections to the drawings have been made. In FIG. 3, "Authorisation" has been changed to "Authorization". In FIG. 4, one of the reference numerals 400 has been corrected to 430. In FIG. 6, the label "Modem" has been added to items 600a, 600b, and 600c. In FIG. 7, the label "Policy Repository" has been corrected to "Policy Domain" as described in the specification. Replacement drawing sheets incorporating these corrections are attached. The Examiner's approval of the corrected drawings is respectfully requested.

4.) Examiner Objections - Claims

In paragraph 3 of the Office Action, the Examiner objected to claim 13 due to an informality. The Applicant has amended claim 13 to change "authorising" to "authorizing". The Applicant notes that claim 13 was not otherwise rejected in the Office Action. Therefore, the allowance of amended claim 13 is respectfully requested.

5.) Claim Rejections – 35 U.S.C. § 102(e)

In paragraphs 4-5 of the Office Action, the Examiner rejected claims 14-17 under 35 U.S.C. § 102(e) as being anticipated by Peck (US 6,606,491). The Applicant has amended claims 14, 16, and 17 to better distinguish the claimed invention from Peck. The Examiner's consideration of the amended claims is respectfully requested.

The Examiner equated the policy enforcement point in claim 14 to a SIM card in Peck. Peck discloses a dual-mode mobile terminal capable of operating with both GSM and D-AMPS networks. The dual-mode mobile terminal stores a terminal-based ESN and MIN for accessing the D-AMPS network while the SIM card stores a separate ESN and MIN for use in accessing the GSM network.

The Applicant has amended claim 14 to recite a policy enforcement point for enforcing policies for two different heterogeneous networks. The policies are defined in a policy definition point. The policy enforcement point includes a policy enforcement engine for controlling at least one task of the policy enforcement point; and a policy repository for storing subscriber information and policies relating to the two different heterogeneous networks.

The Applicant notes that the SIM card in Peck does not enforce policies for two different networks. The SIM card only works with the GSM network. Therefore, the SIM card does not include all aspects of the claimed policy enforcement point recited in amended claim 14. Therefore, the withdrawal of the § 102 rejection and the allowance of amended claim 14 are respectfully requested.

The Applicant has also modified the claim dependencies of claims 15-17 to form a chain rather than each depending directly from base claim 14. Therefore, claims 16 and 17 now have additional features, which must be disclosed in Peck for the § 102 rejection to stand. The Applicant contends that Peck does not disclose these features. Therefore, the allowance of claims 15-17 is respectfully requested.

6.) Claim Rejections – 35 U.S.C. § 103(a)

In paragraphs 10-11 of the Office Action, the Examiner rejected claims 1, 3 and 7-11 under 35 U.S.C. § 103(a) as being unpatentable over Poole (UK 2,292,653) in view of Peck. The Applicant contends that under 35 U.S.C. § 103(c), Peck is disqualified as prior art because Peck and the present application were commonly owned at the time the invention was made. More specifically, MPEP 706.02(l)(1) states:

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." This change to 35 U.S.C. 103(c) applies to all utility, design, and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution applications filed under 37 CFR 1.53(d), and reissues.

The instant application was filed on January 15, 2001, which is after November 29, 1999. Applicant respectfully notes that the instant application and Peck were, at the time the invention was made, owned by the same entity, i.e., Telefonaktiebolaget LM Ericsson. The ownership information is indicated on the face of Peck, and is shown for the instant application in an assignment executed by the inventor on May 30, 2001, and recorded with the U.S. Patent and Trademark Office at reel 012028, frame 0139.

As a result, all of the requirements of 35 U.S.C. 103(c) have been met, and Peck is disqualified as a prior art reference in the instant application. Poole by itself, does not teach or suggest the claimed invention. Therefore, Applicant respectfully requests the withdrawal of the rejection and the allowance of claims 1, 3, and 7-11.

In paragraph 19 of the Office Action, the Examiner rejected claims 2 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Poole-Peck, and further in view of Emilsson, et al. (US 6,498,788). As noted, Peck is disqualified as prior art under 35 U.S.C. § 103(c). Without Peck, a prima facie case of obviousness has not been established with respect to claims 2 and 4. Therefore, Applicant respectfully requests the withdrawal of the rejection and the allowance of claims 2 and 4.

In paragraph 18 of the Office Action, the Examiner rejected claims 5 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Poole-Peck, and further in view of

Martini, et al. (US 6,675,015). As noted, Peck is disqualified as prior art under 35 U.S.C. § 103(c). Without Peck, a prima facie case of obviousness has not been established with respect to claims 5 and 6. Therefore, Applicant respectfully requests the withdrawal of the rejection and the allowance of claims 5 and 6.

7.) Prior Art Not Relied Upon

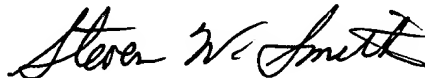
In paragraph 22 of the Office Action, the Examiner stated that the prior art made of record and not relied upon is considered pertinent to the Applicant's disclosure. However, Applicant's reading of these references has not revealed a policy enforcement point as claimed by the Applicant.

CONCLUSION

In view of the foregoing remarks, the Applicant believes all of the claims currently pending in the Application to be in a condition for allowance. The Applicant, therefore, respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance for claims 1-11 and 13-17.

The Applicant requests a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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